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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/661,587

09/15/2003

Kuo-Jung Hsu

TOP 322

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WASHINGTON, DC 20005

EXAMINER

SHERMAN, STEPHEN G

ART UNIT

PAPER NUMBER

2629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/661,587	<b>Applicant(s)</b> HSU, KUO-JUNG	
	<b>Examiner</b> Stephen G. Sherman	<b>Art Unit</b> 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 3 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 August 2006 has been entered. Claims 1-16 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawa et al. (JP 2002-297309).

**Regarding claim 1**, Kawa et al. disclose a notebook computer with a hidden touch pad (Drawing 1), comprising:

a main portion including a housing portion (Drawing 1 shows body 2 which is a housing portion.),

wherein the housing portion has an internal surface having an receiving portion (Drawing 3b and paragraph [0023] explain that the body 2 has the surface shown as item 54 in the drawing, and that this internal side has a portion for receiving the touch pad.);

a display connected to the main portion in a rotatable manner (Drawing 1 shows display section 3); and

a touch pad disposed onto the receiving portion (Drawing 3b shows that touchpad portion 53 is received by the body 2.);

wherein the receiving portion of the internal surface prevents the touch pad from being exposed to an atmosphere outside of the housing portion (Paragraph [0024]).

**Regarding claim 2**, Kawa et al. disclose the notebook computer as claimed in claim 1, wherein the housing portion further includes an external surface (Drawing 1).

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**Regarding claim 4**, Kawa et al. disclose the notebook computer as claimed in claim 1, wherein the receiving portion has a concave portion (Paragraph [0025] states that the material where the track pad 53 is located should be made to be thin, which means that if that it is thin and the rest of the surface is thicker, then this portion will be concave.).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawa et al. (JP 2002-297309).

**Regarding claim 7**, Kawa et al. disclose the notebook computer as claimed in claim 1.

Kawa et al. fail to teach of the notebook computer wherein the thickness of the receiving portion is about 0.5-0.8mm.

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to make the thickness of the receiving portion between .5-.8 mm since a notebook computer is portable and it is important to have the overall size of the notebook computer be relatively small meaning that all the components located inside of the computer would also need to be small.

**Regarding claim 8**, Kawa et al. disclose the notebook computer as claimed in claim 1.

Kawa et al. fail to teach of the notebook computer wherein the difference between the thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing is about 0.7-1.0 mm.

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to make the difference between the thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing to be about 0.7-1.0 mm because it is important for the housing to keep a

relatively small size but still be thicker than other components in the computer such that the internal components are protected properly.

**Regarding claim 9**, Kawa et al. disclose the notebook computer as claimed in claim 1.

Kawa et al. fail to teach of the notebook computer wherein a ratio between the thickness of the receiving portion and the thickness a portion, adjacent to the receiving portion, of the housing is about  $1/3$ - $1/2$ .

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to make the ratio between the thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing to be about  $1/3$ - $1/2$  mm because it is important for the housing to keep a relatively small size but still be thicker than other components in the computer such that the internal components are protected properly.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawa et al. (JP 2002-297309) in view of Garner (US 6,501,462).

**Regarding claim 3**, Kawa et al. disclose the notebook computer as claimed in claim 2.

Kawa et al. also disclose wherein the housing further includes a concave or convex Braille points on the external surface that surround the surface corresponding to the receiving portion, however, Kawa et al. fail to teach that there is a flange surrounding the receiving portion.

Garner discloses of a notebook computer wherein the housing further includes a flange on the external surface, and the flange surrounds the surface correspond to the receiving portion (Figure 1, item 39 and column 4, lines 5-12. The examiner interprets that item 39 is a flange which surround the touch pad portion item 35.).

Therefore it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to use the flange taught by Garner with the notebook computer taught by Kawa et al. in order to provide improved tactile feedback such that the touchpad can be found without looking for it with the eye.

9. Claims 5-6 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawa et al. (JP 2002-297309) in view of Keely, JR. et al. (US 2002/0063694).

**Regarding claim 5**, Kawa et al. disclose the notebook computer as claimed in claim 1.

Kawa et al. fail to teach of the notebook computer further comprising: an adhesive member adhering the touch pad to the receiving portion.

Keely, JR. et al. disclose of a notebook computer further comprising: an adhesive member adhering a touch pad to the outer surface opening (Paragraph [0041]).



Therefore it would have been obvious to “one of ordinary skill” in the art at the time the invention was made to adhere the touch pad using adhesive as taught by Keely, JR. et al. to the outer edges of the receiving portion of the notebook computer taught by Kawa et al. in order to provide the desired stiffness, producing permanent alignment, shock control, the spread of impact forces along the edges, and liquid seal, with minimum cost, weight, and number of parts.

**Regarding claim 6**, Kawa et al. and Keely, JR. et al. disclose the notebook computer as claimed in claim 5.

Keely, JR. et al. also discloses wherein the touch pad is closely adjacent to the outer surface opening via the adhesive member, thereby eliminating any gap between the outer surface opening and the touch pad (Paragraph [0041]. The examiner interprets that when anything is sealed with an adhesive such that liquids are prevented from entering that the gap between the two items is eliminated.).

**Regarding claim 10**, this claim is rejected under the same rationale as claims 1 and 5.

**Regarding claim 11**, this claim is rejected under the same rationale as claims 5 and 6.

**Regarding claim 12**, this claim is rejected under the same rationale as claim 7.

**Regarding claim 13**, this claim is rejected under the same rationale as claim 8.

**Regarding claim 14**, this claim is rejected under the same rationale as claim 9.

**Regarding claim 15**, Kawa et al. and Keely, JR. et al. disclose the method as claimed in claim 10.

Kawa et al. and Keely, JR. et al. fail to teach of the method wherein the housing is formed by injection molding.

However, it would have been obvious to “one of ordinary skill” in the art at the time the invention was made to form the housing using injection molding since it is well known that the injection molding process has high production rates, allows design flexibility, has relatively low labor, and has minimum scrap losses.

**Regarding claim 16**, this claim is rejected under the same rationale as claim 4.

### **Conclusion**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen G. Sherman whose telephone number is (571) 272-2941. The examiner can normally be reached on M-F, 8:00 a.m. - 4:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS

1 February 2007

AMR A. AWAD  
SUPERVISORY PATENT EXAMINER

A handwritten signature in black ink, appearing to read "Amr A. Awad", is written over a diagonal line that extends from the bottom right of the printed name and title.